

### **REMARKS/ARGUMENTS**

#### **Status of the claims**

Claims 1, 5, 7 to 23 and 26 to 28 were previously pending and presented for examination. Claims 1, 14, 27 and 28 are herein amended. After entry of these amendments, claims 1, 5, 7 to 23 and 26 to 28.

Claims 1, 5, 7-23 and 26-28 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 1, 5, 7-23 and 26-28 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Zavada et al./ U.S. Patent number 5,955,075 (issued September 21, 1999/ IDS reference 11 submitted March 31, 2005), and further in view of Zisman et al. (Journal of Clinical Oncology 19(6): 1649-1657, March 15, 2001/ IDS reference 83 submitted March 31, 2005) and Belldegrün et al./ U.S. Patent Application Publication number 2002/0058041 A1 (published May 16, 2002).

Claims 1, 5, 7-23 and 26-28 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/34650 (published December 21, 1995), and further in view of Zisman et al. (Journal of Clinical Oncology 19(6): 1649-1657, March 15, 2001/ IDS reference 83 submitted March 31, 2005) and Belldegrün et al./ U.S. Patent Application Publication number 2002/0058041 A1 (published May 16, 2002).

#### **Support for the amendments to the claims**

Claims 1 and 14 were amended to set forth use of the prognosis in the selection of the treatment regimen for the subject. Support for this subject matter is found in the title of the specification itself "Methods of Renal Cell Carcinoma Prognosis and Treatment Selection with Carbonic Anhydrase IX" as well as in the specification at paragraph 33 which sets forth that the term prognosis can embrace "the determination of the preferred therapeutic regimen for a patient." Further support is found in the title of the section entitled "Renal Cell Carcinoma Prognosis and Therapy Selection." (see, p. 13 of the specification as filed.

Claims 27 and 28 were amended to accord with the change in the antecedents afforded by claims 1 and 14, respectively.

Accordingly, the Applicants believe the amendments to the claims add no new matter and respectfully request their entry.

**Response to the rejection of all the pending claims pursuant to 35 U.S.C. §112, first paragraph.**

Without acquiescing on the merits and in the spirit of expediting examination, the Applicants have amended the base claims. As amended the base claims set forth subject matter fully supported by the specification as discussed above. Accordingly, the Applicants respectfully request reconsideration and withdrawal of this grounds of rejection.

**Response to the rejections pursuant to 35 U.S.C. 103(a).**

Both rejections pursuant to 35 U.S.C. 103(a) rely in part upon U.S. Patent Application Publication No. 20020058041 which was published on May 16, 2002. The instant application claims priority benefit of U.S. Provisional Application Serial No. 60/373,193 filed April 16, 2002 which discloses use of CAIX expression data in therapy planning of patients with RCC (paragraph 6, last line). The '193 priority document also discloses stratification of quantification percentages of about 85% at p. 9, lines 11 to 17. Accordingly, U.S. Patent Application Publication No. 20020058041 represents 35 U.S.C. §102(e). art which may be removed pursuant to 35 U.S.C. §103(c), by a suitable declaration of common ownership as set forth in MPEP §706.02(L)(2). The Applicants provide below the required statement of common ownership and accordingly request that both rejections under 35 U.S.C. §103 be reconsidered and withdrawn.

**Statement of Common Ownership at the time the instant invention was made**

On behalf of the Applicants, the undersigned states that the instant invention of the above-captioned 10/511,465 application and the invention of U.S. Patent Application Publication No. 20020058041 were each owned by the same person or subject to an obligation of

assignment to the same person at the time the instant invention was made. As evidence thereof the Applicants provide copies of the USPTO patent recorded assignments database as accessed on February 9, 2010 (Appendix A).

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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